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10/038,004	01/02/2002	Daniel R. Baum	Shutterfly 04C001	8059

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EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,004

Applicant(s)

BAUM, DANIEL R.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Amendment a, paper number 4, received on 10/9/2002 is acknowledged and entered. A new claim 21 has been added. Currently claims 1-21 are pending for examination.

Response to Arguments

2. Applicant's arguments filed with regards to claims 1-21 on 10/09/2002 have been fully considered but they are not persuasive.

With regards to applicant's remarks concerning independent claims 1 and 21, "...The Section 102 Rejections.....However, Shiota does not show the specifics of how image orders are sent to multiple recipients However, the discussion below is silent on whether the customer can order for all recipients at once or one recipient at a timedistributing the printed cards having the recipients' uploaded images to their respective associated recipients " (amendment page 6, line 8-page 8, line 11) and " Since at least one element is missing in Shiota, Shiota cannot anticipate independent claims 1 and 21 or those dependent therefrom " (amendment page 9, lines 24- 25), examiner begs to differ for following reasons:

(i) Claims 1 and 21 recite a broad limitation, " distributing the printed cards having the recipients' uploaded images to their respective associated recipients " without further limiting as what means are used to distribute them. Therefore, applicant's remarks "...However, Shiota does not show the specifics of how image orders are sent to multiple recipients " are not relevant to the claims 1 and 21. Nevertheless, as stated in the applicant's disclosure distribution/delivery

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can be done through mail, Shiota also discloses distributing by mail (at least see col.4, lines 43-54, and col.9, lines 6-16).

(ii) Shiota discloses ordering at once for a plurality of recipients (at least see col.11, line 38-col.12, line 24). Shiota teaches that a customer can place orders for him and his friends and that is ordering for a plurality of recipients.

(iii) In claim 21, the limitation, " receiving a card order from an orderer, such order specifying a plurality of recipients other than the orderer " is negative and not supported by the applicant's instant specification. The specification does not teach that orderer is not a recipient but instead it discloses that one of the recipients is different from the orderer (see specification, page 3, lines 29-32, "In one aspect, a computer-implemented method of distributing image prints to a plurality of recipients (including, e.g., an individual, a business entity, and/or an address) may include receiving an order specifying a plurality of recipients (e.g., where at least one of the specified recipients is different from a user from whom the order was received "). Therefore, this negative limitation constitutes new matter.

With regards to applicant's remarks regarding claim 4, " Additionally, claim 4.....textual message for the printed cards " (amendment page 9, lines 26-28), examiner respectfully differs as Shiota/Tackbary discloses the specifics of print parameters that include one or more of print size, number of copies, print finish (at least see Shiota, Fig.2, col.3, lines 31-45, Tackbary, abstract, col.2, lines 42-46, "...It is yet.....upon receiving order...print the buyer's messages on the cards, and send the cards to the buyer or to the recipients " and Tackbary, col.13, lines 16-24 , "...the quality of user printed cards depend upon the quality of the user's printer 1230 and the paper quality ").

With regards to applicant's remarks regarding claims 5-6, " ..Shiota shows that a print service....there is no teaching in Shiota that a user directly uploads the images " (amendment,

page 9, line 28-page 10, line 1), examiner respectfully differs as Shiota teaches that a user directly uploads the images from a digital camera to a printing service (see Shiota, col.2, lines 33-41, “..The picture image obtained by a laboratory means a.....picture image obtained from a memory or the like of a digital camera brought in by a customer.....”). The applicant’s specification also discloses a similar embodiment for uploading images by the user (see page 17, lines 12-16).

With regards to applicant’s remarks regarding claim 9, “ With respect to claim 9, Shiota does not show the web front-end for a user.....over Shiota” (amendment, page 10, lines 2-4), examiner respectfully differs as Shiota discloses the web front-end for a user (see Shiota, col.10, lines 32-col.11, line 21, “...A WWW browser 30 has been installed in the personal computer 6.....A WWW application server 36 which communicates with the WWW browser 30 of the personal computer 6..”. Note: WWW application server 36 relates to web-front end computer in the application.).

With regards to applicant’s remarks regarding claims 11-12, “ Shiota also does not show a single transaction sequence terminated by a click of a “ card order” button (amendment, page 10, lines 4-7), examiner respectfully differs as Shiota shows a single transaction sequence terminated by a click of a “ card order” button (at least see, col.8, lines 17-31. Here, Shiota discloses using a single transaction sequence by generating order information for all the recipients [see col.9, line 38-col.10, line 3] and then can generate the order information by merely confirming the thumbnail image of the user’s picture. The confirmation of thumbnail image relates to clicking a card order button in the application to terminate the transaction sequence.

In view of the above, 102 rejection of claims 1, 3, 5-12, 14, and 16 is maintained.

With regards to applicant's remarks regarding claims 2,4,15, and 17-20, since 102 rejection of independent claims 1 and 14 is maintained, 103 rejection in view of Shiota/Tackbary is also maintained.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 21, the limitation, "receiving a card order from an orderer, such order specifying a plurality of recipients other than the orderer" is negative and not supported by the applicant's instant specification. The specification does not teach that orderer is not a recipient but instead it discloses that one of the recipients is different from the orderer (see specification, page 3, lines 29-32, "In one aspect, a computer-implemented method of distributing image prints to a plurality of recipients (including, e.g., an individual, a business entity, and/or an address) may include receiving an order specifying a plurality of recipients (e.g., where at least one of the specified recipients is different from a user from whom the order was received"). Therefore, this negative limitation constitutes new matter. Note: In view of this first paragraph 112 rejection, the limitation "receiving a card order from an orderer, such order specifying a plurality of recipients other than the orderer" in claim 21 will not be considered

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.

5. Claims 1, 3, 5-12, 14, 16, and 21 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Shiota et al. (US Patent 6,324,521)

With regards to claims 1 and 21, Shiota teaches a computer implemented method of distributing cards to a plurality of recipients, the method comprising:

Receiving a card order specifying a plurality of recipients and, for each specified recipient, a set of one or more uploaded images associated with that recipient (col.10, line 33-col.11, line 21. Note, Here, Shiota teaches that the center server receives an order from the customer (personal computer 6) which includes uploaded image data for the prints ordered for recipients. The orders include postcards (col.3, lines 31-35) and picture postcards (col.4, lines 28-32) which correspond to a card order in the application. Col.11, line 38-col.12, line 24 discloses that there are plurality of recipients (customer and his/her friend). Also see Fig.1 (6-PC correspond to plurality of recipients)

For each of the plurality of recipients specified in the received card order, printing at least one card having at least one uploaded image from the recipient's image set and distributing the printed cards having the recipients' uploaded images to their respective

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associated recipients (col.11, lines 38-col.12, line 24. Customer and his friend are the plurality of recipients and prints (which could be photograph/postcards/picture postcards as disclosed in col.3, lines 31-35 and col.4, lines 28-32) with uploaded images are distributed to customer and to the customer's friend).

With regards to claims 3 and 10, Shiota discloses that image set differ from one recipient to second recipient and also diving the received card order into a plurality of sub-card orders, each sub-card order corresponding to a different recipient (col.11, lines 38-col.12, line 24. Note: picture a for the customer and picture b for the friend. Pictures a and b could be different and can be ordered by customer and friend separately via Internet).

With regards to claims 5-8, Shiota teaches that the images are uploaded by a user from a digital camera (col. 2, lines 34-42, "...a picture image obtained from a memory or the like of a digital camera ") to a printing service (at least see, Fig.6. Center Server is the printing service. Also see col.10, line 30-col.11, line 21 and col.1, line 56-col.2, line 10), receiving, printing and distributing is dispersed among two or different entities (at least see, Fig.6. Center Server is the printing service. Also see col.10, line 30-col.11, line 21 and col.1, line 56-col.2, line 10. Note: laboratory server and center server are tow or different entities) or can be performed by a single entity (col.1, lines 29-38, "...However, it is preferable to have only one wholesale labdata management ").

With regards to claim 9, Shiota teaches receiving orders for picture postcard by an enterprise providing a web front-end (See. Figs.1 and 6. Also see col.10, lines 30-41).

With regards to claims 11-12, Shiota teaches that card order comprises a single transaction and is terminated by a click of a "card order" button (col.8, lines 17-30, "...can request a printing service without going to the minilab 3 by carrying out a predetermined input on an order screen through confirmation of the thumbnail image.....". Note: thumbnail image

corresponds to "card-order" button and confirmation of thumbnail image corresponds to a single sequence transaction)

With regards to system claims 14, and 16, all of their limitations are similar to the limitations of method claims 1, 7, and 11-12 analyzed above and are rejected similarly.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 4 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota et al. , and further in view of Tackbary et al. (US Patent 6,092,054).

With regards to claims 2, 4 and 15, Shiota teaches a computer-implemented method and system of distributing cards to a plurality of recipients, as disclosed in claims 1 and 14 above. Shiota further teaches printing of postcards and picture and postcards (col.3, lines 31-35, and col.4, lines 27-31) and cards could differ in size, copies, finish (col.3, lines 31-45, "...postcard generation.....size of the print, and the number of the print..."). Shiota does not disclose printing a greeting card and a playing card with textual message. However, Tackbary teaches printing a greeting card and a playing card with textual message which are grouped under "social expression cards " (at least see, col.1, line 19-col.2, line 46, "....The invention relates... ordering, and delivering social expression cards.....upon receiving an order, to select designated cards....print the buyer's messages on the cards, and send the cards to the buyer or the recipients"). In view of Tackbary, it would have been obvious to a person of an ordinary skill

in the art at the time of the invention to modify Shiota to include the feature of printing and distributing greeting card, playing card or other social expression cards along with picture postcard with textual message. Doing so would allow the customer in Shiota to modify the picture postcards to social expression cards, like greeting cards or playing cards, with textual messages and send them on occasions like birthdays/anniversary, etc. and thereby eliminating the need to spend time and effort in buying them from another source.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota et al.,

With regards to claim 13, Shiota teaches a computer implemented method of distributing cards to a plurality of recipients, as disclosed in claim 1 above. Shiota further teaches payment method (Fig.2). Shiota does not disclose charging to one or more of a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon. However, it is a generally known information that while shopping/placing orders via Internet/WWW payment is made via one of the many notoriously known means of a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon. Therefore, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to charge, in Shiota, via one of the many notoriously known means of a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon.

9. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota et al., and further in view of Tackbary et al. (US Patent 6,092,054).

With regards to claims 17, Shiota (col.1, line 56-col.12, line 24) teaches all the limitations of the claims. Shiota does not teach obtaining message data from the user specifying message content to be included in the print communications and including this message data in the print communications. However, Tackbary obtaining message data from the user specifying message

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content to be included in the print communications and including this message data in the print communications (at least see, col.1, line 19-col.2, line 46, "...The invention relates... ordering, and delivering social expression cards... ..upon receiving an order, to select designated cards....print the buyer's messages on the cards, and send the cards to the buyer or the recipients"). In view of Tackbary, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Shiota to include the feature of obtaining message data from the user specifying message content to be included in the print communications and including this message data in the print communications. Doing so would allow the customer in Shiota to modify the picture postcards to include the message content in the print communications to use them as social expression cards, like greeting cards/anniversary cards, etc. thereby eliminating the need to spend time and effort in buying social expression cards, like greeting cards, from another source.

With regards to claims 18-20, Shiota/Tackbary teaches uploading images from a digital camera or a data storage (col. 2, lines 34-42, "...a picture image obtained from a memory or the like of a digital camera". Note: memory corresponds to a data storage device) and uploading to a printing device (at least see, Fig.6. Center Server is the printing service. Also see col.10, line 30-col.11, line 21 and col.1, line 56-col.2, line 10).

Conclusion

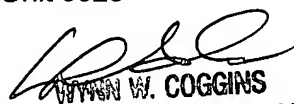
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg
Examiner
Art Unit 3625

YCG
December 12, 2002


WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
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